

Remarks

Claims 1, 3-9, 11, 12, 14-21, 23-25, 28-31, 33, 35-41, 43-49, 51, 53-66, 69-78, 80-90, 92-93, and 95-113 are in the application. Claims 1, 33, 63, 65, 66, 78, 102, and 108 are in independent form. Reconsideration is requested.

Claims 1, 3-9, 11-21, 23-25, 28-31, 33, 35-41, 43-49, 51, 53-66, 69-78, 80-90, 92-93, and 95-113 stand rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement. The Examiner submits that the term "not being in wired communication" lacks sufficient support in the specification. Applicants respond as follows.

The independent claims have been amended to replace the term "not being in wired communication" with the term "being in wireless communication" to more literally matched the terminology used throughout the application and shown specifically in Fig. 2A and described at paragraphs [0082]-[0085], for example. The examiner notes that "the specification provides support for wireless communication." Applicant requests, therefore, that this rejection be withdrawn.

Claims 1, 3-5, 7-9, 11-21, 23-25, 29-30, 33, 35-37, 39-41, 51, 53-55, 69-74, 76-78, 92-93, and 95-113 stand rejected under 35 USC 102(e) for anticipation by Atkinson et al. (2002/0012329) (hereafter Atkinson). Claims 6, 28, 38, 56, 57, 75, and 85 are rejected under 35 USC 103(a) for obviousness of Atkinson in view of Naito (US Pat. No. 6,628,417). Applicants traverse these rejections for the following reasons.

Original Atkinson Rejection

As previously noted, the Atkinson application was filed May 4, 2001, which is after the November 1, 2000 filing date of provisional application no. 60/245,101 to which the present application claims benefit under 35 USC 119(e). Atkinson is prior art to the present application only if subject matter relied upon by the Examiner in the rejection has an effective filing date earlier than November 1, 2000. However, as indicated below, subject matter relied upon by the Examiner in the rejection has an effective filing date after November 1, 2000. As a

consequence, Atkinson is not prior art to the present application and the rejections should be withdrawn.

The Atkinson application is the culmination of a chain of ten provisional patent applications, as indicated by the Related US application data for Atkinson:

This Application is related to and claims priority from the following commonly assigned Applications: Provisional Application Ser. No. 60/224,701, filed Aug. 11, 2000; Provisional Application 60/227,878, filed Aug. 25, 2000; Provisional Application 60/243,654, Oct. 26, 2000; Provisional Application 60/250,928, filed Dec. 1, 2000; Provisional Application 60/254,595, filed Dec. 11, 2000; Provisional Application Ser. No. 60/208,967, filed Jun. 2, 2000; Provisional Application Ser. No. 60/220,047, filed Jul. 21, 2000; Provisional Application 60/239,320, filed Oct. 10, 2000; Provisional Application Ser. No. 60/267,555, filed Feb. 9, 2001; and Provisional Application 60/271,607, filed Feb. 26, 2001.

The Examiner cites in the November 25, 2008 Office action paragraph [102] of Atkinson as disclosing various features recited in the claims. Paragraph [102] of Atkinson provides the only description of Fig. 10 of Atkinson. A drawing similar to Fig. 10 of Atkinson is first included in provisional application 60/254,595, filed Dec. 11, 2000, after the November 1, 2000 effective filing date of the present application. There is no description nor any disclosure in the '595 provisional application corresponding to paragraph [0102] of the Atkinson application. The subject matter of paragraph [102] and the associated Fig. 10 of the Atkinson application are first included together in provisional application 60/271,607, filed Feb. 26, 2001, which is also after the November 1, 2000 effective filing date of the present application. The subject matter of paragraph [102] of the Atkinson application corresponds to page 39 of the '607 provisional application, and associated Fig. 10 corresponds to page 51 has a filing date of Feb. 26, 2001, which is after the November 1, 2000 effective filing date of the present application.

All the rejections set forth in the November 25, 2008 Office action rely on paragraph [102] and associated Fig. 10 of the Atkinson patent application. Fig. 10, with no associated description, was first included in a provisional application dated December 11, 2000, and subject matter corresponding to paragraph [102]

was first included in a provisional application dated February 26, 2001. None of the subject matter of paragraph [102] of Atkinson forming the basis of the Examiner's rejections has an effective filing date earlier than the November 1, 2000 effective filing date of the present application.

New Atkinson Rejection

The Examiner states in the March 10, 2009 Advisory action that Atkinson provisional application 60/243,654, filed 10/26/2000, "teaches discovery of devices and a list of devices and providing this list to the Java application. But also inherent (see page 10) to the use of Bluetooth is the standard and its utilization by the prior art and inherit [sic, inherent] to the standard discover and utilization of the devices that are found." Applicant responds as follows.

As noted by the Examiner, the Atkinson '654 provisional application is directed to providing "Bluetooth-enabled devices the ability to sense other Bluetooth-enabled devices within a communications range using Java based technology." (Atkinson '654 provisional application pages 1 and 2.) As further support, the Examiner cites page 10 of the Atkinson '654 provisional application, which is reproduced below:

Registers the listener to receive neighborhood change events

Parameters:

1 - the listener to add

removeNeighborhoodListener

```
public void removeNeighborhoodListener(NeighborhoodListener l)
```

Removes the listener from receiving neighborhood change events

Parameters:

1 - the listener to remove

getDeviceList

```
public java.lang.String[] getDeviceList()
```

Gets a list of string representations of the addresses of all the devices currently in the neighborhood

Returns:

an array of strings representing the addresses of all the devices in the neighborhood

[Overview](#) [Package](#) [Class Tree](#) [Deprecated](#) [Index](#) [Help](#)

[PREV CLASS](#) [NEXT CLASS](#)

[SUMMARY](#) [INNER](#) [FIELD](#) [CONSTR](#) [METHOD](#)

[FRAMES](#) [NO FRAMES](#)

[DETAIL](#) [FIELD](#) [CONSTR](#) [METHOD](#)

The Examiner also attaches, but does not rely upon, a Bluetooth White Paper titled "Mapping Solution Architecture APIs to Bluetooth Service Discovery Layer." The Examiner seems to conclude that the cited passages of the Atkinson '654 provisional application, either alone or in combination with the Bluetooth White Paper, describes each and every feature of each claim in the present application. Applicant traverses this rejection for the following reasons.

The following remarks are directed to independent claim 1, but are similarly applicable to each of the other independent claims in the application.

Claim 1 currently recites:

1. (Currently amended) A data output method for rendering at one or more output devices data content accessed from a wireless mobile information apparatus, the one or more output devices and the wireless mobile information apparatus being in wireless communication with each other, the method comprising:

establishing at the wireless mobile information apparatus a radio frequency wireless communication channel directly between the wireless mobile information apparatus and the one or more output devices;

receiving at the wireless mobile information apparatus over the radio frequency wireless communication channel one or more device-dependent attributes corresponding to the one or more output devices;

selecting at the wireless mobile information apparatus a selected output device from the one or more output devices;
generating a device-dependent output from the data content for rendering at the selected output device, the device-dependent output being based at least in part on the one or more attributes corresponding to the selected output device; and
delivering the device-dependent output over the radio frequency wireless communication channel directly from the wireless mobile information apparatus to the selected output device for rendering of the data content.

The Examiner cites passages of the Atkinson '654 provisional application that describe Bluetooth-enabled devices that sense other Bluetooth-enabled devices within a communications range. The Bluetooth White Paper describes device discovery in greater detail.

However, the cited passages of the Atkinson '654 provisional application and the Bluetooth White Paper make no mention of aspects of the invention, as described in the specification, including discovering a print service, gathering print information, receiving device dependent printer attributes, sending or receiving a print profile, generating device dependent output based at least in part on the one or more printer attributes received etc.

With regard to the claims, the Atkinson '654 provisional application and the Bluetooth White Paper refer to Bluetooth device discovery, but make no mention or teaching of utilizing discovered devices in a manner relating to an output service. The Atkinson '654 provisional application and the Bluetooth White Paper do not teach or suggest receiving at the wireless mobile information apparatus over the radio frequency wireless communication channel one or more device-dependent attributes corresponding to the one or more output devices, generating a device-dependent output from the data content for rendering at the selected output device, the device-dependent output being based at least in part on the one or more attributes corresponding to the selected output device, or delivering the device-dependent output over the radio frequency wireless communication channel directly from the wireless mobile information apparatus to the selected output device for rendering of the data content.

More specifically, the Atkinson '654 provisional application and the Bluetooth White Paper make no mention of output devices and, accordingly, make no mention of establishing a radio frequency wireless communication channel directly between wireless mobile information apparatus and one or more output devices. Nothing in the generalized Bluetooth functionality described in the Atkinson '654 provisional application or the Bluetooth White Paper inherently suggests a radio frequency wireless communication channel directly between a wireless mobile information apparatus and one or more output devices. A feature is inherent in a prior art reference only if the feature is a "necessary feature or result." (MPEP 2112.) Nothing in the generalized Bluetooth functionality described in the Atkinson '654 provisional application or the Bluetooth White Paper necessarily requires that a Bluetooth device be an output device. Applicant submits, therefore, that the Atkinson '654 provisional application and the Bluetooth White Paper do not teach or suggest every feature recited in the claim and that the rejection is improper and should be withdrawn.

In addition to making no mention of output devices, the Atkinson '654 provisional application and the Bluetooth White Paper make no mention and provide no description or teaching of receiving at a wireless mobile information apparatus over a radio frequency wireless communication channel one or more device-dependent attributes corresponding to the one or more output devices. Nothing in the generalized Bluetooth functionality described in the Atkinson '654 provisional application or the Bluetooth White Paper inherently suggests sending one or more device-dependent attributes corresponding to the one or more output devices to a wireless mobile information apparatus. A feature is inherent in a prior art reference only if the feature is a "necessary feature or result." (MPEP 2112.) Nothing in the generalized Bluetooth functionality described in the Atkinson '654 provisional application or the Bluetooth White Paper necessarily requires that one or more device-dependent attributes corresponding to the one or more output devices be sent to a wireless mobile information apparatus. Applicant submits, therefore, that the Atkinson '654 provisional application and

the Bluetooth White Paper do not teach or suggest every feature recited in the claim and that the rejection is improper and should be withdrawn.

In addition to making no mention of output devices or receiving device dependent attributes corresponding to the output device, the Atkinson '654 provisional application and the Bluetooth White Paper make no mention of generating a device-dependent output from data content for rendering at a selected output device, the device-dependent output being based at least in part on the one or more attributes corresponding to the selected output device, and delivering the device-dependent output over the radio frequency wireless communication channel directly from the wireless mobile information apparatus to the selected output device for rendering of the data content. Nothing in the generalized Bluetooth functionality described in the Atkinson '654 provisional application or the Bluetooth White Paper inherently suggests generating a device-dependent output from data content for rendering at a selected output device or delivering the device-dependent output over directly from the wireless mobile information apparatus to the selected output device for rendering of the data content. A feature is inherent in a prior art reference only if the feature is a "necessary feature or result." (MPEP 2112.) Nothing in the generalized Bluetooth functionality described in the Atkinson '654 provisional application or the Bluetooth White Paper necessarily requires generating a device-dependent output from data content, or rendering of data content, or generating a device-dependent output based at least in part on the one or more attributes corresponding to the selected output device. Applicant submits, therefore, that the Atkinson '654 provisional application and the Bluetooth White Paper do not teach or suggest every feature recited in the claim and that the rejection is improper and should be withdrawn.

For the reasons set forth above, applicant submits that claim 1, as well as the other independent claims and all the dependent claims, recite numerous features that are not disclosed and are not inherent in the Atkinson '654 provisional application or the Bluetooth White Paper, or any of the other cited art.

Applicant believes the application is in condition for allowance and respectfully request the same.

IPSOLON LLP
111 SW COLUMBIA #710
PORTLAND, OREGON 97201
TEL. (503) 249-7066
FAX (503) 249-7068

Respectfully Submitted,

/Mark M. Meininger/

Mark M. Meininger
Registration No. 32,428